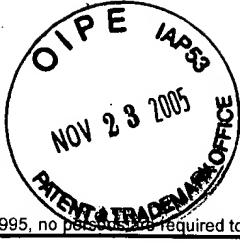


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

MFSI-001/01US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

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Application Number

09/702,045

Filed

October 31, 2000

First Named Inventor

Louis J. Morsberger

Art Unit

3639

Examiner

Akiba K.

Robinson-Boyce

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record
Registration number 34,262

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



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11/23/05

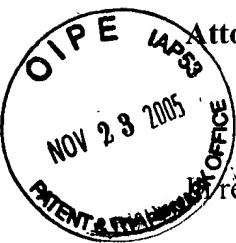
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket No. MFSI-001/01US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Prior application of Louis J. MORSBERGER

Examiner: Akiba K. Robinson-Boyce

Serial No.: 09/702,045

Art Unit: 3639

Filed: October 31, 2000

Confirmation No.: 8530

For: **SYSTEM AND METHOD FOR COLLECTING SURVEY INFORMATION
FROM TARGETED CONSUMERS**

U.S. Patent and Trademark Office
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401 Dulany Street
Alexandria, VA 22314

ARGUMENTS IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW

Applicant submits the following arguments in support of the Pre-Appeal Brief Request for Review filed herewith.

A. Shkedy and Boe Are Not Properly Combinable

The Examiner has rejected all of the pending claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,260,024 to Shkedy (“Shkedy”) in view of U.S. Patent No. 6,236,975 to Boe (“Boe”). Applicant respectfully submits that the references are not properly combinable and therefore that the Examiner has failed to establish a *prima facie* case of obviousness.

Shkedy is directed to a bilateral, buyer-driven system for creating binding purchase contracts. Individual buyers’ purchase requirements are aggregated into a single collective purchase requirement, and sellers are solicited to bid on the collective purchase order. An intermediary communicates the purchase orders and bids between the buyers and the sellers. *Shkedy* emphasizes that the disclosed system preserves the anonymity of the buyers and sellers. For example, *Shkedy* notes that:

The present invention provides for the anonymity of both buyers and sellers. Such anonymity is accomplished by eliminating all references to names of the individuals for all transactions. . . . In this embodiment the payment protocol of buyers paying the intermediary and then the intermediary paying the seller ensure complete anonymity for both buyer and seller. This is desirable if the buyer were an

individual who did not want to be inundated with direct mail solicitations usually generated from the purchase of certain item [sic].

Another advantage afforded to buyers is the ability to provide them with a confidential shield from credit card companies and others who are trying to ascertain their buying habits and preferences. If the buyer buys through an intermediary, and then has the goods shipped through a third party, it is possible for them to maintain complete confidentiality in their purchases.

Col. 24, line 54 – col. 25, line 7.

Consistent with this objective of preserving anonymity, *Shkedy* makes no mention of any mechanism for surveying buyers regarding any transaction in which they have participated. Although there is a dispute resolution mechanism that can be invoked when a buyer is not satisfied with a purchase, this mechanism is invoked by the buyer. See col. 27, lines 25-62,

In contrast, *Boe* is directed to a targeted marketing system:

In general, the system of the present invention allows a business to survey specific customers and to identify ones of such customers that might want to purchase particular products or services. This is accomplished by encouraging the customer to complete a series of demographic questions.

Col. 2, line 66 – col. 3, line 3.

Thus, *Shkedy* teaches away from using the targeted marketing survey system of *Boe*. Modifying *Shkedy* to add the survey system of *Boe* would entail destroying the very anonymity and shielding of the buyer from solicitations and monitoring of buying habits that *Shkedy* identifies as an important feature of his system.

The Examiner has not identified any motivation to combine the references based on any disclosure within the references, and certainly no motivation that can reconcile the conflicting teachings of the two references. Rather, the Examiner recites generalities such as “the motivation of collecting the owner’s views in order to get a better idea of how to improve the processing of the transaction,” “the motivation of collecting survey answers from an appropriate consumer,” and “the motivation of determining if the consumer would be worth keeping and performing transactions with.”

The Examiner’s combination of these two references is improper and the Examiner therefore has not established a *prima facie* case of obviousness of any of the claims.

B. Independent Claims 1, 25 and 26 are Patentable over *Shkedy* and *Boe*

Independent claims 1, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shkedy* in view of *Boe*. Applicant respectfully submits that, even if the cited references were properly combinable, the rejection is not supported by the references, because the references omit the essential element, common to all of these claims, of “determine whether to invite the consumer to complete a survey” based on a comparison of consumer information and/or a comparison of merchant information.

The Examiner acknowledges that *Shkedy* fails to disclose this element. The Examiner’s reliance on *Boe* to supply this missing element is misplaced. As discussed in more detail at pages 8-10 of Applicant’s Reply and Amendment filed April 29, 2005 (which discussion is incorporated by reference), the portion of *Boe*’s disclosure on which the Examiner relies does not teach the artisan how to “determine whether to invite the consumer to complete a survey” based on a comparison of consumer information and/or a comparison of merchant information. Rather, *Boe* is concerned with storing data regarding the survey question last answered by a customer so that when the customer returns later to finish the survey, the system can present the subsequent question without requiring the customer to start again from the first question.

The Examiner asserts that *Boe* discloses “determining what subsequent question to present to a customer when a customer returns to a survey after he or she partially completes the survey” and that the “determination is made based on customer data stored in the matching database about which question he or she answered last relating to business products / services.” The Examiner’s own characterization of the teaching of *Boe* makes clear that the rejection is ill-founded. The claims require a determination of whether to invite the consumer to complete a survey, which determination is based on a comparison of consumer information and/or a comparison of merchant information, where each of the comparisons involves information related to the transaction that is the subject of the survey. In contrast, *Boe* does not disclose, and the Examiner’s rejection thus does not address, any determination of whether to invite the consumer to complete a survey, much less any such bases for a determination. In *Boe*, if a consumer returns, the system will present the next question – there is no determination of whether to present the next question, or whether to invite the consumer to complete a survey at all.

C. Independent Claim 10 is Patentable over *Shkedy* and *Boe*

Independent claim 10 also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shkedy* in view of *Boe*. Applicant respectfully submits that, even if the cited references were properly combinable, the rejection is not supported by the references, because the references omit the essential elements of “develop historical consumer information” and of “determine, using the historical consumer information, whether to collect survey information from the consumer in the transaction.”

The Examiner asserts that *Shkedy* discloses developing consumer information from participating consumers. However, the portion of *Shkedy*’s disclosure on which the Examiner relies simply indicates that buyer database 255 maintains data on buyers with fields that include credit history, and that the information is obtained when the buyer first registers with the system or immediately prior to his first FPO 100. *Shkedy*, Col. 10, lines 1-7. In contrast, claim 10 includes the element of “develop historical consumer information.” The plain meaning of “develop” is “to acquire gradually,” or “to expand by a process of growth.” This is consistent with Applicant’s disclosure, in which historical information is developed by collecting information over time. Examples include historical participant information such as how many times a participant has been invited to complete a survey and which invited participants have completed a survey (page 8, lines 1-3) and additional participant information such as whether a participant completed a survey, which surveys a participant completed, the participant’s incentive selections, the participant’s incentive account data, and identification of transactions for which a survey was received (page 12, line 16 – page 13, line 5). *Shkedy*’s disclosure of obtaining a credit history at a single point in time does not meet the claimed element of developing historical consumer information.

The Examiner concedes that *Shkedy* fails to disclose determining whether to collect survey information, and relies on the same disclosure in *Boe* as cited for claims 1, 25, and 26. For the same reasons as discussed above in connection with the rejection of those claims, and for the reasons discussed at pages 10-11 of the April 29 Reply (which discussion is incorporated by reference), Applicant respectfully submits that *Boe* fails to disclose “determine, using the historical consumer information, whether to collect survey information from the consumer in the transaction.”

D. Independent Claim 16 is Patentable over Shkedy and Boe

Independent claim 16 also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shkedy* in view of *Boe*. Applicant respectfully submits that, even if the cited references were properly combinable, the rejection is not supported by the references, because the references omit the essential element of “determine whether to solicit survey information from the consumer to the transaction based at least partially on the transaction record and the stored consumer information.”

The Examiner concedes that *Shkedy* fails to disclose determining whether to solicit survey information, and relies on the same disclosure in *Boe* as cited for claims 1, 25, and 26. For the same reasons as discussed above in connection with the rejection of those claims; and for the reasons discussed at pages 11-12 of the April 29 Reply (which discussion is incorporated by reference), Applicant respectfully submits that *Boe* fails to disclose “determine whether to solicit survey information from the consumer to the transaction based at least partially on the transaction record and the stored consumer information.”

E. Dependent Claims 2-9, 11-15, and 17-24 are Patentable over Shkedy and Boe

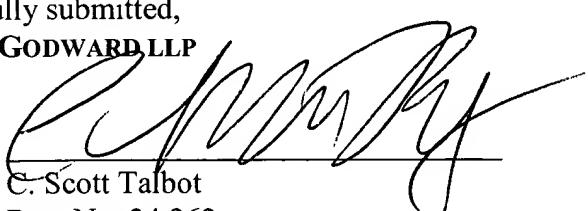
These claims, dependent from claims 1, 10, and 16, are patentable for at least the reasons identified above for their respective independent claims.

CONCLUSION

For the foregoing reasons, the Applicant respectfully requests the panel of Examiners review the final rejection and issue a decision that the pending claims are allowed.

Dated: 11/23/05

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